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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/754,378	01/05/2001	Craig W. Barnett	55534.00045	4429
29315	7590	10/10/2003	EXAMINER	
MINTZ LEVIN COHN FERRIS GLOVSKY AND POPEO PC 12010 SUNSET HILLS ROAD SUITE 900 RESTON, VA 20190			DURAN, ARTHUR D	
			ART UNIT	PAPER NUMBER
			3622	

DATE MAILED: 10/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/754,378	BARNETT ET AL.
Examiner	Art Unit	
Arthur Duran	3622	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 03 September 2003.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 76-89 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 76-89 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948) 4-9-11  
 3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 9-10
- 4) Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.  
 5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

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## **DETAILED ACTION**

1. Claims 76-89 have been examined.

### ***Response to Amendment***

2. The Amendment filed on 9/3/03 is sufficient to overcome the prior rejection.

### ***Double Patenting***

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 76-89 provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 63-74 of copending Application No. 09/321,597. Although the conflicting claims are not identical, they are not patentably distinct from each other.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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Claim 76-81, 83-89 rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1-8 of U.S. Patent No. 6,321,208. Although the conflicting claims are not identical, they are not patentably distinct from each other.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claim 82 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 82 discloses, "...coupon is provided to the user via an electronic mail message". However, the Applicant's specification does not disclose utilizing an electronic mail message to provide to the user the coupon.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 76-89 are rejected under 35 U.S.C. 103(a) as being unpatentable over Von Kohorn (5,227,874) in view of Saigh (5,734,823).

Claim 76, 88: Von Kohorn discloses a method for viewing and printing at a remote terminal user-specific incentives, the method comprising:

storing at a network-accessible location incentive information pertaining to a group of available incentives (col 74, lines 33-40; col 16, lines 30-40; col 19, lines 20-39; Fig. 29, item 904; col 94, lines 35-41; col 95, lines 5-10; col 45, line 41-44);

storing user profile information and user usage history information for one or more users (col 3, lines 33-col 4, line 2; col 1, line 55-col 2, line 48; col 46, lines 41-46; col 113, lines 20-22); receiving at the network-accessible location, from a user of a remote terminal, a request for access to the stored incentive information (col 2, line 65-col 3, line 2);

determining at the network-accessible location if the user is a registered user, and if the user is not registered (col 3, line 56-col 3, line 66; col 94, line 56-col 94, line 70; col 97, line 64-col 98, line 5; col 100, lines 42-50; col 103, line 65-col 104, line 3.);

- i) transmitting a prompt to the user's remote terminal to electronically complete a user profile (col 46, lines 41-46; col 113, lines 20-22);
- ii) receiving and storing the user profile (col 3, lines 33-col 4, line 2; col 1, line 55-col 2, line 48; col 46, lines 41-46; col 113, lines 20-22); and
- iii) downloading to the user's remote terminal an incentive data management software module for managing the printing of incentives (col 2, lines 55-63; col 14, lines 20-25; col 10, lines 40-45; col 13, lines 60-66; col 74, lines 33-40; col 16, lines 35-40; Fig. 30), wherein a printed incentive includes unique user identification information (col 10, lines 40-45; col 137, lines 25-30);

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if the user is registered, the user viewing a subset of incentives from the group of available incentives, the subset of incentives being based on user-specific information, which comprises at least one of the user profile information and the user usage history information (col 2, line 6-37; col 3, lines 55-col 4, line 2; col 106, lines 1-10; col 2, lines 49-56); the user selecting one or more incentives from the subset of incentives for printing, each of the one or more incentives comprising various fields, including a redemption amount field and at least one other field, the redemption amount field comprising data indicative of a discount provided by the incentive, the redemption amount field and at least one other field being variable in accordance with user-specific information associated with the requesting user, wherein the at least one other field includes unique user identification information (col 37, line 10-35; col 3, lines 45-50; col 22, lines 1-15); printing at the remote terminal, under control of the incentive data management software module, one or more of the user-selected incentives (col 37, line 10-35); subsequent to a user redeeming one or more of the printed incentives, providing at least incentive redemption data to at least one incentive distributor or incentive issuer to enable the at least one incentive distributor or incentive issuer to use at least the incentive redemption data for market analysis to compile at least one subsequent incentive targeted specifically at the user; and making the at least one subsequent incentive available to the user (col 3, line 33-col 4, line 2; col 1, lines 25-42; col 1, line 59-col 2, line 20).

Von Kohorn further discloses that the method can utilize a variety of networks (col 44, line 45-col 45, line 15; col 88, line 55- col 89, line 15).

Von Kohorn does not explicitly disclose that the communication channel can be the Internet.

However, Saigh discloses the utilization of the Internet for the dissemination of a variety of information (col 1, lines 38-41; col 5, lines 20-30), that coupons can be transmitted to users (col 14, lines 60-65; col 8, lines 3-6) and that the coupons can be printed (col 8, lines 59-61).

Saigh further discloses that the service system is associated with an Internet web site (col 14, lines 15-21).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's utilization of the Internet to Von Kohorn transmitting coupons. One would have been motivated to do this because the Internet is a readily available way to transmit information.

Claim 77: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that the step of storing at an Internet-accessible location incentive information pertaining to a group of available incentives further comprises storing advertising materials provided by one or more incentive issuers or distributors (col 2, lines 40-65).

Claim 78: Von Kohorn and Saigh disclose the method of claim 77, and Von Kohorn further discloses that the advertising materials comprise one or more of graphics, text, recipes, competitions, or inducements (col 2, lines 40-65).

Claim 79: Von Kohorn and Saigh disclose the method of claim 77, and Von Kohorn further discloses that the step of enabling a user to view a subset of incentives further comprises the step of enabling the user to view the advertising materials (col 47, line 40-col 48, line 2; col 2, line 65-col 3, line 2; col 81, lines 10-23; col 81, lines 7-40).

Claim 80: Von Kohorn and Saigh disclose the method of claim 76, wherein the user profile received and stored at the Internet accessible location comprises demographic data (col 46, lines 41-46; col 113, lines 20-22).

Claim 81: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that redemption data for multiple users is used by the at least one incentive distributor or incentive issuer for market analysis to compile at least one subsequent incentive targeted specifically at the user (col 1, lines 25-43; col 1, lines 59-col 2, line 11; col 3, lines 55-col 4, line 2; col 106, lines 1-10).

Claim 82, 83: Von Kohorn and Saigh disclose the method of claim 76.

Von Kohorn further discloses that the at least one subsequent incentive is downloaded from the network-accessible location (col 2, line 6-37; col 3, lines 55-col 4, line 2; col 106, lines 1-10; col 2, lines 49-56).

Von Kohorn does not explicitly disclose that the incentives are downloaded from an Internet accessible location.

However, Saigh discloses utilizing the Internet (col 1, lines 38-41; col 5, lines 20-30) and downloading promotional information (col 14, lines 15-31).

Saigh further discloses the utilization of e-mail for incentive related communication (col 14, lines 26-29).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's downloading via the Internet or Saigh's utilization of e-mail to Von Kohorn's downloading incentives. One would have been motivated to do this because the Internet is a readily available network for electronic communication.

Claim 84: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that the at least one subsequent incentive is for a product other than a product covered by the one or more redeemed printed incentives (col 84, lines 11-25; col 106, lines 3-10; col 3, line 37-col 4, line 2).

Claim 85: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that the at least one subsequent incentive is for a same product covered by the one or more redeemed printed incentives, but having a different value (col 3, lines 45-50; col 22, lines 1-15).

Claim 86: Von Kohorn and Saigh disclose the method of claim 76.

Von Kohorn does not explicitly disclose that the at least one subsequent incentive is transmitted to a retailer for electronic redemption.

However, Von Kohorn discloses redeeming incentives at a retailer and mailing incentives for redemption (col 8, lines 47-49), redeeming incentives in a variety of manners including over the phone (col 82, lines 40-45), and the electronic transfer of incentive information to redemption centers (col 40, lines 10-15).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Von Kohorn electronic transfer of redemption information to Von Kohorn varied manners of redeeming incentives. One would have been motivated to do this so that Von Kohorn's users have an additional and convenient way of redeeming incentives.

Claim 87: Von Kohorn and Saigh disclose the method of claim 76.

Von Kohorn further discloses that the service system is associated with a service provider (col 10, lines 21-30; col 88, line 55- col 89, line 15).

Von Kohorn does not explicitly disclose an online service.

However, Saigh discloses online service (col 1, lines 38-41; col 5, lines 20-30).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Saigh's online service provider to Von Kohorn service provider. One would have been motivated to do this because an online service provider is analogous to a service provider.

Claim 89: Von Kohorn and Saigh disclose the method of claim 76, and Von Kohorn further discloses that the incentives available to a user are sorted by categories (col 46, line 62- col 47, line 5).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 76-89 have been considered but are moot in view of the new ground(s) of rejection.

Examiner notes that while specific references were made to the prior art, it is actually also the prior art in its entirety that is being referred to.

### ***Conclusion***

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

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MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

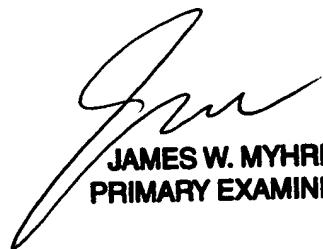
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

AP

9/30/03



JAMES W. MYHRE  
PRIMARY EXAMINER